

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

APPLICATION OF	)	GROUP NO.:	1796
	)		
WERNER OBRECHT ET AL.	)	EXAMINER:	R. SERGENT
	)		
SERIAL NUMBER: 09/739,034	)		
	)		
FILED: DECEMBER 14, 2000	)		
	)		
TITLE: RUBBER MIXTURES BASED	)		
ON UNCROSSLINKED RUBBERS	)		
AND CROSSLINKED RUBBER	)		
PARTICLES AS WELL AS	)		
MULTIFUNCTIONAL ISOCYANATES	)		

**REPLY BRIEF IN RESPONSE TO EXAMINER'S ANSWER**

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

In response to the Examiner's Answer dated September 23, 2008, Appellant hereby submits a Reply Brief in compliance with 37 C.F.R. § 41.41. Accordingly, this Reply Brief is timely filed.

Appellant respectfully submits this brief contains the items required by 37 C.F.R. § 41.41, under appropriate headings and, therefore, complies with MPEP 1208.

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## **I. STATUS OF CLAIMS**

Claims 8-10 and 23-32 are pending in this application. Claims 8-10 and 23-32 are rejected. Claims 1-7 and 11-22 were previously cancelled. The claims on Appeal are Claims 8-10 and 23-32.

Claims 8-10 and 23-32 stand rejected under 35 U.S.C. § 112, first paragraph, as the Office considers them as failing to comply with the written description requirement.

Claims 8-10 and 23-32 stand rejected under 35 U.S.C. §103(a), as the Office considers them to be obvious over U.S. Patent No. 6,127,488 or DE 19701487 to Obrecht et al. in view of U.S. Patent No. 5,232,531 to Dammann et al., JP 57-212239 or JP 05-017630.

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## **II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

1. Whether the term “non-adhesive” in Claims 8-10 and 23-32 is sufficiently supported to comply with the written description requirement under 35 U.S.C. § 112, first paragraph.
2. Whether Claims 8-10 and 23-32 are patentable under 35 U.S.C. § 103(a) over U.S. Patent No. 6,127,488 or DE 19701487 to Obrecht et al. in view of U.S. Patent No. 5,232,531 to Dammann et al., JP 57-212239 or JP 05-017630.

### III. ARGUMENTS

#### A. THE TERM “NON-ADHESIVE” IN CLAIM 8-10 AND 23-32 IS SUPPORTED BY THE SPECIFICATION AS ORIGINALLY FILED.

In the Examiner’s Answer, the Examiner has alleged that “appellants have in no way defined what is meant by non-adhesive,” and claims that “[m]olding compositions, by their very nature, inherently possess some degree of adhesiveness.” Examiner’s Answer, page 3, 2<sup>nd</sup> paragraph under “Issue I.” Appellant respectfully disagrees.

First and foremost, it is well settled that the words of the claims are given their plain meaning unless this meaning is inconsistent with the meaning provided in the specification, and even in the absence of a specific definition for a term in the Specification, a term should be given its “ordinary and customary” meaning. *See* MPEP 2111.01. Appellant respectfully asserts “non-adhesive” is a common English word whose meaning is clear and unquestionable. Moreover, the plain meaning of “non-adhesive” is completely consistent with the exemplary molded bodies recited in claim 10, cable sheaths, hoses, drive belts, etc., prepared from appellant’s non-adhesive rubber vulcanate, and the skilled artisan could certainly ascertain what is meant by “non-adhesive” based on these exemplary embodiments. Furthermore, the Examiner’s assertion that “it cannot be determined exactly what degree of non-adhesiveness is encompassed by the [term non-adhesive]” is completely without base. Appellant respectfully asserts that the inherent degree of non-adhesiveness in a cable sheath, hose, drive belt, etc., which is respectfully very little, is obvious to not only the skilled artisan but the average layperson. Therefore, there is no need to look to outside “[m]olding composition[s]” to

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determine the degree of non-adhesiveness embodied by appellant's "non-adhesive" rubber vulcanates because this degree of non-adhesiveness can be determined based on the molded bodies embodied in Appellant's pending claims. Therefore, the meaning of the term "non-adhesive" in the pending claims is self evident, and because there is no requirement that the specification contain a specific definition for "non-adhesive" because it is a common English word, the Examiner's rationale for rejecting the pending claims under 35 U.S.C. § 112, first paragraph is unfounded.

Secondly, the Examiner's assertion that the Appellant's statement "the vulcanates adhere very greatly to the metal parts of the vulcanizing molds that are used," paragraph [0005] of the Specification as originally filed is "not analogous to stating that vulcanates (i.e.; the cured compositions) are adhesive (i.e.; sticky or tacky)" because "it cannot be deduced from the information provided that the prior art vulcanates (i.e.; cured compositions) are adhesive or sticky or tacky once removed from the mold" (Examiner's Answer, paragraph bridging pages 5 and 6) is also completely unfounded. Given its plain meaning, "adhere very greatly" would mean adhesive or 'very greatly' sticky or tacky. Regardless whether the rubber vulcanate is in the mold or not, 'adhering very greatly,' would clearly indicate that the cured rubber composition exhibits adhesiveness and is more analogous to an adhesive than a non-adhesive. The Examiner appears to assert that the same rubber vulcanite, which is 'adhering very greatly' to the mold, would somehow not exhibit any adhesiveness after being extracted from the mold. However, he offers no sound, logical basis for reaching this conclusion. Therefore, it is unclear how Appellant's interpretation of "adhere very greatly" in the Specification as filed is in any way

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“suspect,” and the Examiner’s assertion that Appellant’s argument that prior art vulcanates exhibit adhesive properties is not supported by the specification is baseless.

For at least the reasons presented above, the meaning of the term “non-adhesive” and the degree of non-adhesiveness embodied by this term are readily apparent based on Appellant’s pending claims. Additionally, Appellant’s Specification supports the assertion that prior art rubber vulcanates containing isocyanates exhibit adhesive properties while Appellant’s claimed rubber are “non-adhesive.” Accordingly, Appellant again respectfully requests that the Office’s rejection under 35 U.S.C. § 112, first paragraph be overturned.

**B. CLAIMS 8-10 AND 23-32 ARE NOT OBVIOUS UNDER 35 U.S.C. § 103(A) OVER U.S. PATENT NO. 6,127,488 OR DE 19701487 TO OBRECHT ET AL. IN VIEW OF U.S. PATENT NO. 5,232,531 TO DAMMANN ET AL., JP 57-212239 OR JP 05-017630.**

It is quite clear from the Examiner’s statements that the obviousness of combining U.S. Patent No. 6,127,488 or DE 19701487 to Obrecht et al. (hereinafter, “Obrecht”) in view of U.S. Patent No. 5,232,531 to Dammann et al. (hereinafter, “Dammann”), JP 57-212239 (hereinafter, “JP ‘239”) or JP 05-017630 (hereinafter, “JP ‘630”) turns on Appellant’s definition of the term “non-adhesive.” Examiner’s Answer, paragraph bridging pages 4 and 5. As described above, Appellant respectfully asserts that the meaning of the term “non-adhesive” is clear and unambiguous based on its plain meaning and the exemplary embodiments of molded bodies provided in claim 10. Appellant further asserts that meaning of “bonding resistant to heat and humidity” (emphasis added) as recited in the cited prior art and identified by the Examiner is also clear and unambiguous.

Appellant respectfully asserts that Dammann and JP '630 clearly describe "adhesives," and because JP '239 uses the same mixture of polyisocyanates and liquid diene rubber as JP '630, it would logically follow that JP '239 would exhibit adhesive properties as well. In fact, the Examiner concedes that these compositions exhibit "bonding resistant to heat and humidity." In contrast, the molded bodies exemplified in Appellant's claims are clearly not "adhesives," and the skilled artisan would logically not utilize a rubber vulcanate that exhibits "bonding resistant heat and humidity" in the manufacture of, for example, a cable sheath. The Examiner has not provided any evidence whatsoever indicating that the addition of polyisocyanates to a previously non-adhesive composition would not confer adhesiveness onto the composition, and in fact, the Examiner asserts that the addition of polyisocyanates would confer upon Appellant's claimed composition "bonding resistant to heat and humidity," *i.e.*, adhesiveness. Therefore, the combination of Obrecht in view of Dammann, JP '239, and JP '630 would not obviously result in Appellant's claimed non-adhesive rubber vulcanate.

The Examiner attempts to reconcile this discrepancy by relying on a JP '239. Examiner's Answer, page 7. Notably, JP '239 is an abstract of less than 150 words. It is not inconceivable that the authors of JP '239 did not think it unnecessary to mention that the compositions exhibit adhesive properties because it was common knowledge at the time that the addition of polyisocyanates to rubber compositions imparted adhesiveness to that composition. Accordingly, Appellant respectfully asserts that the lack of disclosure regarding the adhesiveness of the composition of JP '239 cannot be construed as evidence that the compositions described in JP '239 are non-adhesive.

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The Examiner further attempts to reconcile his statements regarding the addition of polyisocyanates conferring “bonding resistant to heat and humidity” by again asserting that the prior art compositions are adhesive prior to cure but that “cured compositions are no longer adhesive.” Examiner’s Answer, page 8-9. Unfortunately, the Examiner provides no probative evidence of these contentions. Additionally, as noted in the Appeal Brief, page 19, Dammann describes the addition of vulcanizing agents, which would indicate that in at least some embodiments, the compositions of Dammann are vulcanized/cured without any indication that such compositions are no-longer adhesive. Therefore, the Examiner’s statements regarding the adhesive properties of the claimed rubber vulcanates before and after cure amount to nothing more than speculation, which cannot be used to form the basis for a rejection under 35 U.S.C. § 103. *In re Steele*, 305 F.2d 859 (CCPA 1962) (“a rejection under 35 U.S.C. §103 should not be based on considerable speculation about the meaning of terms employed in a claim or assumptions that must be made as to the scope of the claims”), *see also* MPEP 2173.06.

For at least the reasons presented above, the “non-adhesive” properties exhibited by Appellant’s claimed rubber vulcanates could not be expected based on the cited prior art, and the Examiner has failed to provide any evidence otherwise. Accordingly, Appellant’s non-



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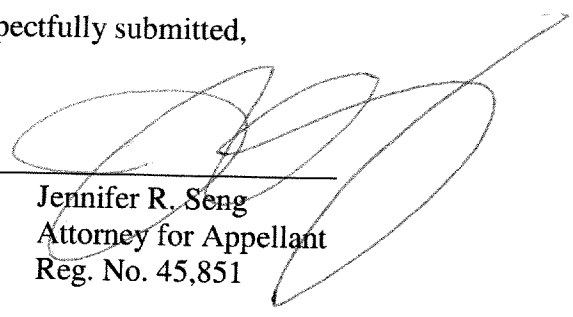
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adhesive rubber vulcanates would not be obvious in the face of the cited prior art, and Appellant respectfully requests that the Office's rejection under 35 U.S.C. § 103(a) be overturned.

Respectfully submitted,

By



Jennifer R. Seng  
Attorney for Appellant  
Reg. No. 45,851

LANXESS Corporation  
111 RIDC Park West Drive  
Pittsburgh, Pennsylvania 15205-9741  
(412) 809-2233  
FACSIMILE PHONE NUMBER:  
(412) 809-1054

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